

**REMARKS**

The following remarks are responsive to the Final Office Action of July 25, 2007.

In the July 25, 2007 Office Action (the “Office Action”), claims 15-19 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,961,081 to Yoshida. Claims 1-14 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,764,800 to Yamagata in view of Yoshida. Applicant traverses the claim rejections and requests reconsideration in view of the remarks and arguments set forth below.

**Claims 15-19**

Claim 15 requires “receiving input from a user as to the number of new photographs the user wants to take” and subsequently “automatically determining the existing images files to be recompressed and the recompression ratios for each existing image file to be recompressed in order to free up enough space on the memory card to accommodate the number of new photographs selected by the user” (emphasis added).

The Office Action contends that Yoshida teaches the aforementioned feature of “receiving input from a user as to the number of new photographs the user wants to take” of independent claim 15. (Office Action, Page 2) This contention is respectfully traversed.

Initially, it is noted that the Office Action has not identified any such teaching in Yoshida of this claim element. Column 10, lines 56-67 and column 11, lines 30-38 cited by the Office Action in support of the contentions that Yoshida teaches the features that immediately precede and follow the claim element of “receiving input from a user as to the number of new photographs the user wants to take,” are silent as to the subject claim element. Still further, Applicant has carefully reviewed the remainder of Yoshida, and finds no teaching of “receiving input from a user as to the number of new photographs the user wants to take.” Thus, for at least this reason, Yoshida cannot anticipate independent claim 15.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 15, and claims 16-19 which depend therefrom, under 35 U.S.C. §102(e) are respectfully requested.

In the event that the Office maintains the rejection of independent claim 15 under 35 U.S.C. §102(e), Applicant respectfully requests that the Office, in the interests of compact prosecution, identify on the record and with specificity sufficient to support a *prima facie* case of anticipation, where in the Yoshida patent the subject claim element of independent

claim 15 of “receiving input from a user as to the number of new photographs the user wants to take” is alleged to be taught.

### **Claims 1-14**

Independent claim 1 (from which claims 2-14 depend) requires “allowing a user to set a number of image files to be added” (emphasis added). The Office Action contends that Yamagata teaches the aforementioned feature. (Office Action, Pages 3-4) This contention is respectfully traversed.

“[A]llowing a user to set a number of image files to be added” means, for example, that “[t]he user is able to set the number of photographs, or image files, to be added, by using the right movement button 40ri of FIG. 2 and the left movement button 40le of FIG. 2.” (Present Application, Page 8, Lines 18-20) Thus, the user is given a choice as to the number of images to be added to the digital camera. For example, in FIG. 2, the user can choose to add between 0 and 10 images. For the record, it should be noted that the user may be able to set the number of images to be added in ways other than by using the right and left movement buttons as described in Lines 18-20.

In clear contrast, Yamagata does not teach “allowing a user to set a number of image files to be added.” In Step 110 and the associated written disclosure in Column 5, Lines 46-60 of Yamagata, a user is not allowed “to set” the number of image files to be added, since the user is not allowed to choose the number of image files to be added. Instead, in Step 110, the user merely indicates that she or he would like to compress a particular image by completely depressing the release button and can make the decision based on the fixed numerical values displayed in Step 109. (See Yamagata, Column 5, Lines 46-55, which describe that if a particular image was compressed, 0 additional files could be recorded in “non-compression mode,” 1 additional file could be recorded in “low compression mode” and 6 additional files could be recorded in “high compression mode,” and therefore, “in Step 109, the numerals 0, 1, and 6 are indicated in this order.”) Thus, the number(s) displayed in Step 109 cannot be altered by a user, and therefore cannot be “set” by a user.

In other words, Yamagata merely displays how image files can still be added. In significant contrast, the present invention provides the functionality for the user to specify a number of image files to be added.

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Application No. 10/736,401  
Response to Final Office Action of July 25, 2007

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1, and claims 2-14 which depend therefrom, under 35 U.S.C. §103(a) are respectfully requested.

**Conclusion**

For the foregoing reasons, all pending claims in the present application are believed to be allowable. Thus, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/brian c. rupp/

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Brian C. Rupp, Reg. No. 35,665  
Jasmine Patel, Reg. No. 59,344  
DRINKER BIDDLE & REATH LLP  
191 N. Wacker Drive, Suite 3700  
Chicago, Illinois 60606-1698  
(312) 569-1000 (telephone)  
(312) 569-3000 (facsimile)  
Customer No.: 08968

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